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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,223	02/16/2001	Loren Swingle	Verizon-6	4340

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EXAMINER	
WEAVER, SCOTT LOUIS	

ART UNIT	PAPER NUMBER
2645	10

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/785,223	SWINGLE ET AL.	
	Examiner	Art Unit	
	Scott L. Weaver	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *18-23,26-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,9-16,24,25 and 29-35* is/are rejected.

7)☒ Claim(s) *6,8 and 17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4,7*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse filed 4/23/2004 of the group I claims 1-17, 24-25, and 29-35 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the inventions are closely related and could be reviewed with a single prior art search.. This is not found persuasive because the particulars of the group II claims are not required in the group I claims, claims of group I if patented could not be used to reject the claims of group II and vice versa, thus supporting the noted distinctness between the claims as presented for examination.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 18-23, and 26-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

3. This application contains claims drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to a final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

5. Claims 1 and 10 are objected to because of the following informalities:

Each abbreviation should be spelled out at least once in each set of claims the first time it appears in the set of claims, see claim 1 which refers to "IP".

In claim 10, "prompt" should be inserted prior to "message" (ln.5) for consistency with claim 9 language.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, reference is made to "said E-mail message" [of claim 1], this phrase lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 7 and 24, are rejected under 35 U.S.C. 102(e) as being anticipated by Qua et al. (#6,222,909).

Qua teaches, (via figures 1, 3-4; col.3,ln.59-col.4,ln.3; col.5,ln.43-col.6,ln.10; col.6,ln.26-40; col.6,ln.46-col.7,ln.19) , method for operating communications device which includes accessing a voice message system (170 figure 1) and retrieving voice message (col.3, ln.61-67) over public switched telephone network (100, col.3,ln.1-7), a digital audio file [of the retrieved message] can be generated and attached to and email message which can then be forwarded to other service subscribers at any email address specified thus using an IP packet to send an email with attached audio file of the message to different service subscribers as pertains to claims 1-2. Qua teaches the user accessing the voice message system by calling and controlling the system via DTMF input as pertains to claim 3 (via col.7 as noted above) and the retrieval by the user 'via any telephone communications device' (via col.3,ln.61-62). With respect to claim 7, a use of the Qua system is enabled to receive email , manipulate email and compose email as known in the art of voice mail and as such is enabled to forward an email received (col.6,ln.3-6) with an attached audio file to various users, the content of emails is not

excluded from including a telephone number therein and users of email are not excluded from calling telephone numbers seen in email messages.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 4, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (#6,222,909) in view of Baxter, Jr. (#6,385,306).

With respect to claim 4, Qua does not teach the user accessing the voice mail system by use of DTMF password input., nor the loading [and playing of] appropriate prompts according to script [schedule] attributed to the subscriber inputs as pertains to claim 9-13.

Baxter, Jr. teaches as is well known in the art of voice message systems the use of a caller identification input obtained from the caller by use of querying prompt (col.10, ln.6-12) and further teaches the use of the prompt generation for guiding the user through system menus which accept the user manipulation via DTMF key input .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the voice message system of Qua to prompt for user identification as taught by Baxter, Jr. for the purpose of ensuring that the user was a valid paying subscriber and to further modify the system of Qua to use the appropriate prompting script as determined by user input as taught by Baxter, Jr. for the purpose of guiding the user through appropriate functions of the system such as to determine when the system is waiting for an input to perform a next function.

13. Claims 5, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (#6,222,909) in view of Yaker (EP 0,893,902 A2).

With respect to claims 5 and 14, Qua teaches the method for controlling voice message system which enables the user to specify in the message sent for the recipient to respond to the message and as claimed provides that an email message is received indicating a voice message was reviewed.

Although Qua does teach enabling access to the voice message system for message manipulation, Qua does not teach the well known function of voice message systems of the user deleting the voice message (as pertains to claim 14 and 5), or accessing the system via telephone call and sending of control signal to delete as pertains

to claim 15, nor that the telephone used is a voice message retrieval and forwarding device as pertains to claim 16.

Yaker teaches enabling a user to delete via use of DTMF signaling stored voice messages (abstract) so that the filling of the system with irrelevant messages can be avoided(col.3,ln.39-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Qua so that the voice messages could be deleted as necessary as taught by Yaker for the purpose of avoiding the filling of the system memory with irrelevant and outdated voice messages.

14. Claims 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (#6,222,909) in view of Chau et al. (#5,751,792)

Qua teaches, (via figures 1, 3-4; col.3,ln.59-col.4,ln.3; col.5,ln.43-col.6,ln.10; col.6,ln.26-40; col.6,ln.46-col.7,ln.19) , method for operating communications device which includes accessing a voice message system (170 figure 1) and retrieving voice message (col.3, ln.61-67) over public switched telephone network (100, col.3,ln.1-7), a digital audio file [of the retrieved message] can be generated and attached to and email message which can then be forwarded to other service subscribers at any email address specified thus using an IP packet to send an email with attached audio file of the message to different service subscribers as pertains to claims 29-31. Qua teaches the user accessing the voice message system by calling and controlling the system via DTMF

input as pertains to claim 33-35 (via col.7 as noted above) and the retrieval by the user 'via any telephone communications device' (via col.3,ln.61-62).

Qua does not teach the use of plurality of voice message systems as per claim 29.

Chau teaches (col.1ln.35-54; col.4,ln.8-31; col.4,ln.48-56) use of plurality of voice message systems enabling user that is using a roaming device to receive voice messages when at a remote location to reduce costs to the subscriber (col.1,ln.27-32) as pertains to claims 29 and 32..

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of qua to include plurality of voice message systems as taught by Chau for the purpose of enabling a roaming subscriber of the Qua system to cost effectively manipulate voice messages as taught by Chau.

Conclusion

15. Claims 6, 8 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record at this time does not teach the combination of limitations as is presented thereby.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Tuesday to Friday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645